

**REMARKS:**

Claims 1-31 are currently pending in the application. Claims 1-31 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,128,759 to Hansen ("Hansen") in view of U.S. Patent No. 6,510,420 B1 to Cessna et al. ("Cessna") in further view of U.S. Patent No. 6,360,332 B1 to Weinberg et al. ("Weinberg").

By this Amendment, independent claims 1, 12, and 22 have been canceled without prejudice and claims 2, 13, and 23 have been amended to place claims 2, 13, and 23 in independent form and to more particularly point out and distinctly claim the Applicants invention. In addition, claims 3-11, 14-21, and 24-31 have been amended to correct certain dependencies. By making these amendments, the Applicants make no admission concerning the merits of the Examiner's rejection, and respectfully deny any statement or averment of the Examiner not specifically addressed. Particularly, the Applicants reserve the right to file additional claims in this Application or through a continuation patent application of substantially the same scope of originally filed independent claims 1, 12, and 22, and to antedate the above-identified prior art reference. No new matter has been added.

The Applicants respectfully submit that these amendments place the Application in better form for Appeal and do not require a new search. Thus, the Applicants respectfully request the Examiner to enter these amendments.

**SPECIFICATION OBJECTION:**

The Applicants thank the Examiner for withdrawing the objection to the specification.

**RESPONSE TO EXAMINERS AMENDMENT REMARKS:**

The Applicants thank the Examiner for fully considering Applicants arguments in the previous Office Action response mailed 2 May 2005. However, the Applicants respectfully submit that the Examiner has mischaracterized the Applicants remarks in the aforementioned Office Action Response. The Applicants do not understand why the mischaracterization is set forth in the subject Office Action and respectfully requests further explanation from the Examiner. The Examiner may call the undersigned at (817) 447-9955 if the Examiner believes that it would be easier to discuss the source of confusion over the phone. Thus, the Applicants respectfully traverse the Examiners assertions regarding these mischaracterizations.

Specifically, the Examiner asserts that the Applicant argues that Hansen, Cessna, and Weinberg fail to disclose, teach or suggest each and every element of claims 1-31. However, the Examiner then contradicts this argument by asserting that the Examiner agrees that Hansen in combination with Cessna and Weinberg meets each and every limitation of claims 1-31. (14 July 2005 Office Action, Page 4). The Applicant respectfully disagrees with this assertion does not understand what the Examiner is agreeing with. The Applicants reiterate their argument set forth in the previous Office Action Response and hereby incorporate all arguments and remarks set forth in the previous Office Action response as if fully set forth herein.

**REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 1-31 stand rejected under 35 U.S.C. § 103(a) over Hansen in view of Cessna and in further view of Weinberg.

Although the Applicants believe claims 1-31 are directed to patentable subject matter without amendment, the Applicants have canceled claims 1, 12, and 22 without prejudice, and amended claims 2, 13, and 23 to place claims 2, 13, and 23 in independent form, and to more particularly point out and distinctly claim the Applicants invention. In

addition, claims 3-11, 14-21, and 24-31 have been amended to correct certain dependencies. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicants respectfully submit that Hansen, Cessna, or Weinberg either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 2-11, 13-21, and 23-31. Thus, the Applicants respectfully traverse the Examiners obvious rejection of claims 1-31 under 35 U.S.C. § 103(a) over the proposed combination of Hansen, Cessna, and Weinberg either individually or in combination.

For example, with respect to amended independent claim 12, this claim recites:

A method for selecting members in a hierarchy, comprising:  
receiving input of a user from a member selection interface;  
determining a sequence of one or more actions associated with a member selection tree, the actions collectively selecting one or more members from a hierarchy of members, the hierarchy of members being associated with a particular dimension of an organization of data;  
recording the sequence of actions of the user in a member selection script; and  
executing the recorded member selection script to generate a new selection of members based upon the members and hierarchical relationships of the users original inputs, after the hierarchy of members has been modified. (Emphasis Added).

Amended independent claims 13 and 23 recite similar limitations. Hansen, Cessna, and Weinberg either individually or in combination, fail to disclose, teach or suggest each and every limitation of amended independent claims 2, 13, and 23.

For example, the Examiner asserted Hansen discloses a method for selecting members in a hierarchy. The Applicants respectfully traverse the Examiners assertions regarding the subject matter disclosed in Hansen.

The Applicants respectfully submit that Hansen does not disclose a method, a system, or software for selecting and recording members in a hierarchy as recited in

amended independent claims 2, 13, and 23. Although Hansen discloses a flexible test environment (Abstract), Hansen does not disclose: (1) receiving input of a user from a member selection interface; (2) determining a sequence of one or more actions associated with a member selection tree, the actions collectively selecting members from a hierarchy of members; or (3) generate a new selection of members based upon the members and hierarchical relationships of the users original inputs, after the hierarchy of members has been modified. Hansen merely describes the test development steps as they relate to the test program execution steps.

The Applicants further submit that Hansen does not receive input of a user from a member selection interface, or even a flexible test environment interface. The Applicants still further submit that Hansen does not collectively select one or more members from a hierarchy of members, trees, or even end leaves in a test program. The Applicants yet further submit that Hansen does not disclose executing the recorded member selection script to generate a new selection of members based upon the members and hierarchical relationships of the users original inputs, after the hierarchy of members has been modified. Thus, Hansen cannot execute the recorded member selection script, since Hansen does not even record a member selection script in the first place. Furthermore, Hansen cannot generate a new selection of members based upon the members and hierarchical relationships of the users original inputs, since Hansen does not even collectively select a member from a hierarchy of members in the first place.

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that Hansen fails to disclose the emphasized limitations noted above in amended independent claim 2. Specifically the Examiner acknowledges that Hansen fails to disclose the hierarchy of members being associated with a particular dimension of an organization of data. (14 July 2005 Office Action, Page 4). However, the Examiner asserts that the cited portions of Cessna disclose the acknowledged shortcomings in Hansen. The Applicants respectfully traverse the Examiners assertions regarding the subject matter disclosed in Cessna.

The Applicants respectfully submit that Cessna has nothing to do with the amended independent claim 2 limitations regarding determining a sequence of actions that collectively select members from a hierarchy of members associated with a particular dimension of an organization of data. Rather, Cessna describes an approach a planner may use to view data at a predetermined granularity. (Column 1, Lines 33-42). This approach merely allows a planner to view data at different levels within a hierarchy and has nothing to do with determining a sequence of actions associated with a particular dimension of an organization of data. Thus Cessna cannot determine a sequence of actions, since Cessna does not even collectively select members from a hierarchy of members associated with a particular dimension of an organization of data.

The Applicants further submit that the Office Action acknowledges, and the Applicants agree, that both Hansen and Cessna, either individually or in combination, further fail to disclose the limitations of claim 1. Specifically the Examiner acknowledges that both Hansen and Cessna fail to disclose recording the sequence of actions in a member selection script. (14 July 2005 Office Action, Page 4). However, the Examiner asserts that Weinberg discloses the acknowledged shortcomings in Hansen and Cessna. The Applicants respectfully traverse the Examiners assertions regarding the subject matter disclosed in Weinberg.

The Applicants respectfully submit that Weinberg fails to disclose the limitations recited in amended independent claim 2 regarding recording the sequence of actions of the user in a member selection script. Rather, Weinberg describes a testing tool for testing the functionality of a transactional server where a series of user steps are recorded. (Figure 6A-6C). The testing tool merely displays these recorded user steps to allow for verification of expected server responses and has nothing to do with recording the sequence of actions of the user in a member selection script. Furthermore, Weinberg fails to disclose recording the sequence of actions of the user, associated with a member selection tree, in selecting at least one member from a hierarchy of members associated with a particular dimension of an organization of data, into a member selection script.

The Applicants respectfully submit that the Examiner has inappropriately applied hindsight when combining the teachings of the Cessna and Weinberg with the teachings of the Hansen in order to arrive at the claimed invention recited in amended independent claim 2. Specifically, the Examiner asserts that portions of the claimed method would have been a highly desirable feature in this art for dynamically building hierarchical groupings of business information based on member characteristics and editing tests without knowing a scripting or other programming language. (14 July 2005 Office Action, Page 4). The Applicants respectfully traverse the Examiners assertions. The Applicants further submit that the reasoning to dynamically build hierarchical groupings of business information based on member characteristics and editing tests without knowing a scripting or other programming language are examples of hindsight inappropriately applied to reach the claimed invention as recited in amended independent claim 2.

The Applicants further submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Hansen, Cessna, and Weinberg, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in Hansen, Cessna, or Weinberg, to combine the references as proposed. The Office Action merely states that it would have been obvious to one of ordinary skill in the art to modify Hansen for the purpose of dynamically building hierarchical groupings of business information as well as editing tests without knowing a programming language. (14 July 2005 Office Action, Pages 4-5).

The Applicants still further submit that this purported advantage relied on by the Examiner to make such a combination is nowhere disclosed, taught, or suggested in Hansen, Cessna, or Weinberg, either individually or in combination. The Applicants respectfully request the Examiner to point to the portions of Hansen, Cessna, or Weinberg, which contain the teaching, suggestion, or motivation to combine Hansen, Cessna, or Weinberg for the purpose of dynamically building hierarchical groupings of business information as well as editing tests without knowing a programming language. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In re Lee,

61 U.S.P.Q.2d 1430 (Fed. Cir. 2002)(Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Hansen, Cessna, or Weinberg, either individually or in combination.

Amended independent claim 2 is considered patentably distinguishable over the proposed combination of Hansen, Cessna, and Weinberg for at least the reasons discussed above. With respect to amended independent claims 13 and 23 each of these claims includes limitations similar to those discussed above in connection with amended independent claim 2. Thus, amended independent claims 13 and 23 are considered patentably distinguishable over the proposed combination of Hansen, Cessna, and Weinberg for at least the reasons discussed above in connection with amended independent claim 2.

With respect to dependent claims 3-11, 14-21, and 24-31; claims 3-11 depend from amended independent claim 2, claims 14-21 depend from amended independent claim 13, and claims 24-31 depend from amended independent claim 23. As mentioned above, each of amended independent claims 2, 13, and 23 are considered patentably distinguishable over the proposed combination of Hansen, Cessna, and Weinberg. Thus, dependent claims 3-11, 14-21, and 24-31 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For the reasons set forth herein, the Applicants submit that claims 2-11, 13-21, and 23-31 are not rendered obvious by the proposed combination of Hansen, Cessna, and Weinberg. The Applicants further submit that claims 2-11, 13-21, and 23-31 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 2-11, 13-21, and 23-31 under 35 U.S.C. § 103(a) be reconsidered and that claims 2-11, 13-21, and 23-31 be allowed.

## **THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.



A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.


Although Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

8/9/05

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